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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/059,381	01/31/2002	Dennis J. O'Rear	005950-746	7484

7590

01/02/2004

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EXAMINER

NGUYEN, TAM M

ART UNIT

PAPER NUMBER

1764

DATE MAILED: 01/02/2004

Please find below and/or attached an Office communication concerning this application or proceeding.

# Office Action Summary

Application No.

10/059,381

Applicant(s)

O'REAR ET AL.

Examiner

Tam M. Nguyen

Art Unit

1764

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --  
Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133).
- Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

## Status

- 1) ☒ Responsive to communication(s) filed on 24 September 2003.
- 2a) ☐ This action is FINAL. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

## Disposition of Claims

- 4) ☒ Claim(s) 1-20 is/are pending in the application.
- 4a) Of the above claim(s) 13, 17 and 20 is/are withdrawn from consideration.
- 5) ☐ Claim(s) \_\_\_\_\_ is/are allowed.
- 6) ☒ Claim(s) 1-12, 14-16, 18 and 19 is/are rejected.
- 7) ☐ Claim(s) \_\_\_\_\_ is/are objected to.
- 8) ☐ Claim(s) \_\_\_\_\_ are subject to restriction and/or election requirement.

## Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☒ The drawing(s) filed on 22 April 2002 is/are: a) ☒ accepted or b) ☐ objected to by the Examiner.  
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).  
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

## Priority under 35 U.S.C. §§ 119 and 120

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).  
a) ☐ All b) ☐ Some \* c) ☐ None of:  
1. ☐ Certified copies of the priority documents have been received.  
2. ☐ Certified copies of the priority documents have been received in Application No. \_\_\_\_\_.  
3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).  
\* See the attached detailed Office action for a list of the certified copies not received.
- 13) ☐ Acknowledgment is made of a claim for domestic priority under 35 U.S.C. § 119(e) (to a provisional application) since a specific reference was included in the first sentence of the specification or in an Application Data Sheet, 37 CFR 1.78.  
a) ☐ The translation of the foreign language provisional application has been received.
- 14) ☐ Acknowledgment is made of a claim for domestic priority under 35 U.S.C. §§ 120 and/or 121 since a specific reference was included in the first sentence of the specification or in an Application Data Sheet, 37 CFR 1.78.

## Attachment(s)

- 1) ☒ Notice of References Cited (PTO-892)
- 2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
- 3) ☒ Information Disclosure Statement(s) (PTO-1449) Paper No(s) 10/02/02.
- 4) ☐ Interview Summary (PTO-413) Paper No(s). \_\_\_\_\_
- 5) ☐ Notice of Informal Patent Application (PTO-152)
- 6) ☐ Other:

## DETAILED ACTION

### *Double Patenting*

The nonstatutory double patenting rejection is based on a judicially created doctrine grounded in public policy (a policy reflected in the statute) so as to prevent the unjustified or improper timewise extension of the "right to exclude" granted by a patent and to prevent possible harassment by multiple assignees. See *In re Goodman*, 11 F.3d 1046, 29 USPQ2d 2010 (Fed. Cir. 1993); *In re Longi*, 759 F.2d 887, 225 USPQ 645 (Fed. Cir. 1985); *In re Van Ornum*, 686 F.2d 937, 214 USPQ 761 (CCPA 1982); *In re Vogel*, 422 F.2d 438, 164 USPQ 619 (CCPA 1970); and, *In re Thorington*, 418 F.2d 528, 163 USPQ 644 (CCPA 1969).

A timely filed terminal disclaimer in compliance with 37 CFR 1.321(c) may be used to overcome an actual or provisional rejection based on a nonstatutory double patenting ground provided the conflicting application or patent is shown to be commonly owned with this application. See 37 CFR 1.130(b).

Effective January 1, 1994, a registered attorney or agent of record may sign a terminal disclaimer. A terminal disclaimer signed by the assignee must fully comply with 37 CFR 3.73(b).

Claims 1-12, 14-16, 18 and 19 provisionally rejected under the judicially created doctrine of obviousness-type double patenting as being unpatentable over claims 1-15, 19-35 and 39-42 of copending Application No. 10/059,383. Although the conflicting claims are not identical, they are not patentably distinct from each other because both sets of claims claim a process for producing gasoline from a Fischer-Tropsch product by hydrotreating to remove oxygenates from a naphtha feedstock and reforming the hydrotreated feedstock. The present claimed set does not specifically disclose that a Fischer-Tropsch naphtha is mixed with a Fischer-Tropsch distillate. However, the present claimed set claims that a Fischer-Tropsch naphtha is mixed with a petroleum derived naphtha. Therefore, it would have been obvious to one having ordinary skill in the art at the time the invention was made to have modified the process of the present claimed set by using a Fischer-Tropsch distillate instead of a petroleum derived naphtha because of the chemical similarities between a Fischer-Tropsch distillate and a petroleum derived naphtha.

Therefore, it would be expected the results would be similar when using a Fischer-Tropsch distillate in the present claimed process.

Claims 1-12, 14-16, 18 and 19 provisionally rejected under the judicially created doctrine of obviousness-type double patenting as being unpatentable over claims 1-11, 13-21 and 24-40 of copending Application No. 10/059,382. Although the conflicting claims are not identical, they are not patentably distinct from each other because both sets of claims claim a process for producing gasoline from a Fischer-Tropsch product by hydrotreating and reforming. The claimed process of the copending application does not specifically disclose that oxygenates are removed in the hydrotreating step. However, the treating step of the claimed process of the copending application is similar to the present claimed process. Therefore, it would be expected that oxygenates are moved in the hydrotreating step of the claimed process of copending applicant as claimed.

This is a provisional obviousness-type double patenting rejection because the conflicting claims have not in fact been patented.

### *Claim Rejections - 35 USC § 103*

The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

The factual inquiries set forth in *Graham v. John Deere Co.*, 383 U.S. 1, 148 USPQ 459 (1966), that are applied for establishing a background for determining obviousness under 35 U.S.C. 103(a) are summarized as follows:

1. Determining the scope and contents of the prior art.
2. Ascertaining the differences between the prior art and the claims at issue.
3. Resolving the level of ordinary skill in the pertinent art.
4. Considering objective evidence present in the application indicating obviousness or nonobviousness.

This application currently names joint inventors. In considering patentability of the claims under 35 U.S.C. 103(a), the examiner presumes that the subject matter of the various claims was commonly owned at the time any inventions covered therein were made absent any evidence to the contrary. Applicant is advised of the obligation under 37 CFR 1.56 to point out the inventor and invention dates of each claim that was not commonly owned at the time a later invention was made in order for the examiner to consider the applicability of 35 U.S.C. 103(c) and potential 35 U.S.C. 102(e), (f) or (g) prior art under 35 U.S.C. 103(a).

Claims 1, 4, 6-12, 14, 16, 18, and 19 are rejected under 35 U.S.C. 103(a) as being unpatentable over of Donald M Little "Catalyst Reforming, PennWell Books" 1985 in view of Derr et al. (4,080,397).

Little discloses a reforming process of a naphtha (e.g., Fischer-Tropsch naphtha) to produce gasoline having an octane number greater than 100 RON by contacting the naphtha with a catalyst. Little discloses that the hydrogen produced from the reforming step can be used in a hydrotreating process. Little also discloses that the gasoline product comprises at least 10 wt. % of aromatics. (See Preface, pages 1-5, 24-27, 40-63, 122)

Little does not disclose that the naphtha feedstock is hydrotreated to remove oxygenates from the naphtha.

Derr discloses a process for producing a distillate (e.g., gasoline) by combining a Fischer-Tropsch naphtha with a petroleum fraction having a high level of sulfur to produce a combined feed having a sulfur content of greater than 10 ppm. The combined feed is then hydrotreated to remove oxygenates from it wherein the hydrotreating catalyst comprises a sulfided non-noble metal such as Ni and Mo. (See abstract; col. 2, line 5 through col. 5, line 15)

Derr does not disclose a reforming process of the naphtha as claimed.

It would have been obvious to one having ordinary skill in the art at the time the invention was made to have modified the process of Little by using a naphtha which has been treated to remove oxygenates as taught by Derr because any naphtha boiling within the gasoline range can be used in the process of Little to produce a high octane gasoline.

Both Little and Derr do not specifically disclose that a FT naphtha is mixed with a petroleum derived naphtha. However, it would have been obvious to one having ordinary skill in the art at the time the invention was made to have modified the process of Little/Derr by using a petroleum distillate because any petroleum fraction which contains sulfur and hydrocarbons that is similar to the FT product can be used in the process of Derr. Therefore, it would be expected that the results would be the same or similar when using either the Derr petroleum fraction or the claimed petroleum distillate in the process of Derr/Little.

Claim 5 is rejected under 35 U.S.C. 103(a) as being unpatentable over references as applied to claims 1-2 above, and further in view of Miller (4,673,487).

Both Little and Derr do not disclose that the sulfiding agent is dimethyldisulfide.

Miller discloses a step of sulfiding the catalyst by treating the catalyst with dimethyldisulfide (see col. 4, lines 21-22).

It would have been obvious to one having ordinary skill in the art at the time the invention was made to have modified the process of Little/Derr by sulfiding the catalyst with dimethyldisulfide as taught by Miller because dimethyldisulfide is an effective sulfiding agent.

Claims 2, 3 and 15 are rejected under 35 U.S.C. 103(a) as being unpatentable over references as applied to claim 1 above, and further in view of Moore (6,583,186).

Both Little and Derr do not disclose that the hydrotreating catalyst comprises noble metal such as Pt.

Moore discloses a hydrotreating catalyst comprising Pt or Ni. (See col. 10, line 23 through col. 11, line 32)

It would have been obvious to one having ordinary skill in the art at the time the invention was made to have modified the combined process of Little/Derr by using a catalyst comprising Pt because Pt has equivalent function as Ni.

#### *Election/Restrictions*

Applicant's election with traverse of Group I filed on September 24, 2003 is acknowledged. The traversal is on the ground(s) that the examination of the subject matter of Group I would likely encompass a search for the subject matter of Group II and additional search would not impose a serious burden. This is not found persuasive because the search required for Group II is not required for Group I because Group II is directed to a composition which can be

Art Unit: 1764

made by hundreds of methods. Therefore, searching the composition in all of the methods (that are different from the method of Group I) is a serious burden.

The requirement is still deemed proper and is therefore made FINAL.

### *Conclusion*

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Tam M. Nguyen whose telephone number is (703) 305-7715.

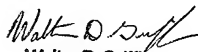
The examiner can normally be reached on Monday through Thursday.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Glenn Caldarola can be reached on 571-272-1444. The fax phone numbers for the organization where this application or proceeding is assigned are 571-272-1452 for regular communications and (703) 305-9311 for After Final communications.

Any inquiry of a general nature or relating to the status of this application or proceeding should be directed to the receptionist whose telephone number is (703) 308-0661.

Tam M. Nguyen  
Examiner  
Art Unit 1764

TN  
December 15, 2003

  
Walter D. Griffin  
Primary Examiner